

UNITED STATES DISTRICT COURT
WESTERN DISTRICT OF WASHINGTON
AT TACOMA

SYNTRIX BIOSYSTEMS, INC.,

Plaintiff,

v.

ILLUMINA, INC.,

Defendant.

CASE NO. C10-5870 BHS

ORDER DENYING PLAINTIFF'S
MOTION TO STRIKE AND
GRANTING IN PART AND
DENYING IN PART THE
PARTIES' *DAUBERT* MOTIONS

This matter comes before the Court on Plaintiff Syntrix Biosystems, Inc.'s ("Syntrix") motion to strike (Dkt. 145) and motion to exclude (Dkt. 150); and Illumina, Inc.'s ("Illumina") motions to exclude (Dkts. 168 & 172). The Court has considered the pleadings filed in support of and in opposition to the motions and the remainder of the file and hereby denies the motion to strike and grants in part and denies in part the motions to exclude for the reasons stated herein.

I. PROCEDURAL HISTORY

On January 22, 2013, Syntrix filed a motion to exclude certain testimony of Dr. Milan Mrksich (Dkt. 150) and a motion to strike the supplemental information of Dr.

1 Mrksich (Dkt. 145); and Illumina filed a motion to exclude the opinions of Alan Ratliff
2 (Dkt. 168) and Dr. Michael Metzker (Dkt. 172). On February 4, 2013, the parties
3 responded. Dkts. 187, 192, 204, & 207. On February 8, 2013, Syntrix replied to
4 Illumina's response to Syntrix's motion to strike. Dkt. 237.

5 II. DISCUSSION

6 A. Motion to Strike

7 Fed. R. Civ. P. 37(c)(1) "forbid[s] the use at trial of any information required to be
8 disclosed by [Fed. R. Civ. P.] 26(a) that is not properly disclosed." *Hoffman v. Constr.*
9 *Protective Servs., Inc.*, 541 F.3d 1175, 1179 (9th Cir. 2008) (quoting *Yeti by Molly, Ltd.*
10 *v. Deckers Outdoor Corp.*, 259 F.3d 1101, 1106 (9th Cir. 2001)). The party facing
11 sanctions bears the burden of proving that its failure to disclose the required information
12 was substantially justified or is harmless. *Torres v. City of L.A.*, 548 F.3d 1197, 1213
13 (9th Cir. 2008).

14 In this case, Syntrix argues that the supplemental report of Dr. Mrksich should be
15 stricken and that he should not be allowed to testify about its contents. Dkt. 145 at 2.
16 Illumina responds that the information provided does not alter Dr. Mrksich's substantive
17 opinions, the information was timely produced, and, even if there is a violation of the
18 rules, the error is harmless and can be corrected by additional depositions before trial.
19 Dkt. 207. The Court agrees that any possible violation can be mitigated. During the
20 pretrial conference, pursuant to the Court's suggestion, the parties agreed to cure the
21 alleged violation of Dr. Metzker's supplemental information via a subsequent deposition
22 and cross-examination. It's arguable that Dr. Metzker provided a wholly new opinion as

1 infringement whereas Dr. Mrksich has only provided new raw numbers relating to the
 2 infringing products, which may be entered into previously disclosed calculations.
 3 Solving problems associated with new opinions is generally more difficult than solving
 4 problems associated with new data. Therefore, the Court denies Syntrix's motion to
 5 strike and exclude Dr. Mrksich's supplemental disclosure because the Court finds that the
 6 parties may resolve any problem with subsequent depositions and cross-examination.

7 **B. *Daubert* Motions**

8 Expert testimony is admissible if it is "scientific, technical, or other specialized
 9 knowledge" that "will help the trier of fact to understand the evidence or to determine a
 10 fact in issue," and "the testimony is based on sufficient facts or data . . . the testimony is
 11 the product of reliable principles and methods; and the expert has reliably applied the
 12 principles and methods to the facts of the case." Fed. R. Evid. 702. The court acts as a
 13 gatekeeper to ensure that expert testimony "is both relevant and reliable." *Avila v. Willits*
 14 *Env'tl. Remediation Trust*, 633 F.3d 828, 836 (9th Cir. 2011). The court may apply four
 15 nonexclusive factors to determine whether proffered expert opinion is developed by the
 16 scientific method or is "junk science":

17 District court judges are to consider not only (1) whether the method has
 18 gained general acceptance in the relevant scientific community, but also (2)
 19 whether the method has been peer-reviewed, (3) whether the method "can
 20 be (and has been) tested," and (4) whether there is a "known or potential
 21 rate of error." [*Daubert v. Merrell Dow Pharmaceuticals, Inc.*, 509 U.S.
 22 579, 594 (1993)] . . . [T]he Daubert inquiry is flexible . . . "One very
 significant fact" is whether the expert has "developed [his] opinions
 expressly for purposes of testifying," since "a scientist's normal workplace
 is the lab or the field, not the courtroom or the lawyer's office." [*Daubert*
v. Merrell Dow Pharmaceuticals, Inc., 43 F.3d 1311, 1317 (9th Cir.), *cert.*
denied, 516 U.S. 869 (1995) ("*Daubert II*")]. That the expert failed to

1 subject his method to peer-review and to develop his opinion outside the
2 litigation is not dispositive, but if these guarantees of reliability are not
3 satisfied, the expert “must explain precisely how [he] went about reaching
4 [his] conclusions and point to some objective source . . . to show that [he
5 has] followed the scientific method, as it is practiced by (at least) a
6 recognized minority of scientists in [his] field.” *Id.*

7 *Lust v. Merrell Dow Pharmaceuticals, Inc.*, 89 F.3d 594, 597 (9th Cir. 1996) (quoting
8 *Daubert II*, 43 F.3d at 1317–1319. “[T]he test under Daubert is not the correctness of the
9 expert’s conclusions but the soundness of his methodology.” *Daubert II*, 43 F.3d at
10 1318. The gatekeeping function applies to all expert opinions, whether based on
11 specialized, technical, or scientific knowledge. *Kumho Tire Co., Ltd. v. Carmichael*, 526
12 U.S. 137, 148–49 (1999). We “determine reliability in light of the particular facts and
13 circumstances of the particular case.” *Id.* at 158.

14 **1. Dr. Mrksich**

15 Syntrix moves to exclude certain testimony of Dr. Mrksich for numerous reasons.
16 Dkt. 150. To the extent that Syntrix moves to exclude based on the information provided
17 in Dr. Mrksich’s supplement produced January 16, 2013, the Court denies the motion
18 because it is repetitive of Syntrix’s motion to strike. The Court will more substantively
19 address the remaining issues.

20 First, Syntrix argues that Dr. Mrksich “skews the data in such a manner that makes
21 it unreliable and not representative of the actual BeadChips.” Dkt. 150 at 6. Illumina
22 counters that “Syntrix argument makes no sense.” Dkt. 204 at 3. The Court agrees to the
extent that Syntrix has failed to show that data is skewed to an unreliable, irrelevant
extent.

1 Second, Syntrix argues that Dr. Mrksich's model includes unrealistic end points
2 that would allow for the physical impossibility of the beads lying below the bottom of the
3 well. Dkt. 150 at 7–9. Illumina, however, has cited the portion of Dr. Mrksich's report
4 that accounts for negative position heights. Dkt. 204 at 6. Therefore, this appears to be a
5 nonissue.

6 Third, Syntrix argues that Dr. Mrksich's testimony should be limited to the actual
7 alleged infringing products that he tested, which was not all of the products. Dkt. 150 at
8 9. Illumina concedes that Dr. Mrksich will testify "consistent with the disclosures he
9 made in his report." Dkt. 204 at 7. Therefore, this appears to be a nonissue.

10 Fourth, Syntrix argues that Dr. Mrksich presents unreliable information regarding
11 2-micron BeadChips. Dkt. 150 at 10. Illumina "contends that the cited documents
12 adequately support Dr. Mrksich's opinion on the issue of 'process agents.'" Dkt. 204 at
13 8. Illumina, however, is incorrect. The first document does not support the conclusion of
14 losses over 20% because it shows losses of only 19.7%. The second document is a red-
15 line revision of comments to a manufacturing process explaining improvement to the
16 19.7% loss. The Court finds that Syntrix has met its burden to exclude paragraphs 160 &
17 161 from Dr. Mrksich's report as well as any testimony on these opinions.

18 Fifth, Syntrix argues that Dr. Mrksich presents no evidence regarding Accused
19 Infringing Assays. Dkt. 150 at 11. Illumina contends that Dr. Mrksich may present
20 evidence that this product is not infringed because the infringement of this product
21 requires infringement of an independent claim and Dr. Mrksich has analyzed products
22 under the independent claim. Dkt. 204 at 9. Moreover, Illumina contends that Dr.

1 Mrksich has provided opinion on Illumina's assays that are not directly linked to
2 Syntrix's patent. *Id.* Therefore, the Court denies Syntrix's motion on this issue.

3 Finally, Syntrix moves to exclude Dr. Mrksich's report and testimony as to
4 Illumina's argument of non-infringement on the "continuous" limitation and affirmative
5 defenses of anticipation and obviousness. Dkt. 150 at 12–14. These issues have been
6 squarely addressed in the Court's order denying the parties' summary judgment motions.
7 *See* Dkts. 183 at 5–8 (affirmative defenses) & 236 at 7. Based on the reasoning contained
8 therein, the Court denies Syntrix's motion.

9 Therefore, the Court grants in part and denies in part Syntrix's motion to exclude
10 the report and testimony of Dr. Mrksich.

11 **2. Dr. Metzker**

12 Illumina moves to exclude Dr. Metzker's opinions on infringement, information
13 relating to Syntrix's state law claims, and the enablement of certain pieces of prior art.
14 Dkt. 172.

15 **a. "Substantially Uniform Thickness"**

16 Illumina argues that the Court should exclude Dr. Metzker's opinion on the
17 "substantially uniform thickness" limitation because it "is not based on sufficient facts or
18 data and is not the product of reliable principles and methods." Dkt. 172 at 5. The Court
19 construed this limitation in part to require that "the thickness of the coating varies by no
20 more than 30% over the entire coated area." Dkt. 75 at 6. It's undisputed that the
21 protrusion height of particles above the substrate is one of the determinative factors as to
22 whether the accused products fall within the scope of this limitation. Syntrix contends

1 that “[u]nsuprisingly, the experts disagree on which statistical data should be used to
2 calculate the protrusion height.” Dkt. 192 at 3. Syntrix goes on to show that Illumina’s
3 problems with Dr. Metzker’s opinion go to the weight and are not the type of
4 fundamental problems that should result in exclusion of the evidence altogether. *Id.* at 3–
5 6. The Court agrees and, therefore, denies Illumina’s motion on this issue.

6 **b. Failure to Follow Claim Construction Order**

7 The Court has discretion to exclude expert testimony “as irrelevant because it [is]
8 based on an impermissible claim construction” *Liquid Dynamics Corp. v. Vaughn*
9 *Co., Inc.*, 449 F.3d 1209, 1224 n.2 (Fed. Cir. 2006).

10 In this case, Illumina argues that portions of Dr. Metzker’s opinion should be
11 excluded as irrelevant because they are based on an improper claim construction. Dkt.
12 172 at 5–12. With regard to the “gelled network” limitation and the linking of the
13 particles, Illumina’s arguments were denied on summary judgment. Dkt. 236 at 5.

14 With regard to the “substrate” limitation, Illumina’s arguments are confusing.
15 First, Illumina appears to argue that Dr. Metzker’s opinions are irrelevant because he
16 treats optional embodiments as requirements of the claim. *See, e.g.*, Dkt. 172 at 8 (“Dr.
17 Metzker treats flatness as a requirement.”). The Court declines to exclude these opinions
18 because whether specific embodiments or products characteristic of specific
19 embodiments are encompassed within a claim limitation is relevant evidence. On the
20 other hand, if Dr. Metzker attempts to narrow the claim limitation to specific
21 embodiments to overcome indefiniteness or prior art (Dkt. 172 at 8), then the testimony
22

1 may be irrelevant and inadmissible. This possible issue, however, may be adequately
2 handled during trial.

3 Second, Illumina argues that “Dr. Metzker’s analysis of the ‘substrate’ limitation
4 is also unreliable because it ignores obviously relevant portions of the patent’s ‘Substrate
5 Selection and Preparation’ discussion.” Dkt. 172 at 9. Illumina contends that it is not a
6 “competent” analysis and that it “is not good enough to support an expert opinion.” *Id.* at
7 9–10. These issues, however, are subjects of cross-examination because they go to the
8 weight of the evidence and not the admissibility. Therefore, the Court denies the motion
9 on the “substrate issue.”

10 With regard to the “known discrete full thickness volume” limitation, Illumina
11 basically argues that Dr. Metzker may not offer testimony that narrows the limitation to
12 overcome indefiniteness. Dkt. 172 at 10–12. Although the Court agrees, this does not
13 make his opinions as to how the accused product falls within the scope of the claims
14 irrelevant or unreliable. Therefore, the Court denies Illumina’s motion on this issue.

15 **c. Information Relating to State Law Claims**

16 Illumina moves to exclude a number of “improper opinions relating to” Syntrix’s
17 state law claims. Dkt. 172 at 12. Syntrix argues that the opinions that support the now
18 dismissed state law claims also support Syntrix’s position that the patent is not invalid
19 and claim for willful infringement. Dkt. 192 at 12–15. The Court agrees to a certain
20 extent. For example, Dr. Metzker’s opinions as to secondary considerations of non-
21 obviousness are admissible and will help the jury to understand the issue. Dkt. 192 at 13.
22 Moreover, Dr. Metzker’s opinions as to the extent of technical information that was

1 disclosed to Illumina and the similarities between the disclosed information and the
2 Dickson application are relevant to willful infringement and will help the jury understand
3 the issue of willfulness. *Id.* at 14. On the other hand, the jury does not need an expert
4 opinion on issues such as the similarities between the words “Syntrix” and “Sentrix.”
5 Dkt. 172 at 15–16. Therefore, the Court denies the motion to exclude all of this evidence
6 with the understanding that specific objections will be addressed when inadmissible
7 testimony is proffered.

8 **d. Enablement**

9 For a reference to anticipate: “[f]irst, the reference must disclose each and every
10 element of the claimed invention, whether it does so explicitly or inherently.” *In re*
11 *Gleave*, 560 F.3d 1331, 1334 (Fed. Cir. 2009). “Second, the reference must enable one of
12 ordinary skill in the art to make the invention without undue experimentation.” *Id.*
13 (quoting *Impax Labs., Inc. v. Aventis Pharms. Inc.*, 545 F.3d 1312, 1314 (Fed. Cir. 2008))
14 (internal quotation marks omitted).

15 In this case, Illumina argues that Dr. Metzker “applied the incorrect standard in
16 reaching his opinions that the prior art references were not enabling.” Dkt. 172 at 18.
17 The Court agrees as to some opinions. For example, Dr. Metzker opines that “Chee II
18 does not enable one of ordinary skill in the art . . . [because] there were no actual
19 reductions to practice of any of the embodiments described in the application.” Ex. B ¶
20 203. This opinion is improper because a valid patent does not require an actual reduction
21 to practice as it is widely known that an individual may possess an enforceable patent
22 without possessing an actual product. In other words, the law only requires sufficient

1 disclosure to enable one to reduce the invention to practice. *See In re Gleave*, 560 F.3d at
2 1334.

3 Syntrix, however, contends that when read in the context of the entire section of
4 Dr. Metzker's opinion, the contested opinion is admissible testimony. Dkt. 192 at 17.
5 The Court disagrees as no context will save the incorrect statement. Therefore, the Court
6 grants the motion on this opinion and any other opinion of prior art based on this
7 particular reasoning. The Court notes that Dr. Metzker offers other admissible opinions
8 on the issue of anticipation, and the Court is confident that the attorneys will seek to offer
9 only those opinions at trial.

10 **3. Mr. Ratliff**

11 Illumina moves to exclude the report of Mr. Ratliff, Syntrix's damages expert.
12 Dkt. 168. Illumina contends that (1) Mr. Ratliff relies on licenses that have no
13 demonstrative link to the technology at issue; (2) Mr. Ratliff improperly supports his rate
14 determination; and (3) Mr. Ratliff improperly speculates as to Illumina's license with
15 Tufts University. *Id.* at 5. Syntrix counters that Illumina's "complaints 'go to the weight
16 of the testimony and not its admissibility.'" *Activision Networks, Inc. v. Verizon*
17 *Comm'ns, Inc. et al.*, 694 F.3d 1312, 1333 (Fed. Cir. 2012). The Court agrees.

18 First, Mr. Ratliff relied on previous expert testimony that the licenses in question
19 were related to DNA microarrays. If Illumina elects to attack that link or the prior expert
20 testimony at trial, then it may. But this is not a sufficient reason to exclude Mr. Ratliff's
21 report and testimony.
22

1 Second, Illumina contends that Mr. Ratliff improperly considers Dr. David Walt's
2 personal stake in Illumina. Dkt. 168 at 9–12. However, the inference that Tufts
3 University received a lower royalty rate from Illumina in return for its doctor receiving a
4 partial stake in Illumina is reasonable. Attacking this inference goes to the weight of Mr.
5 Ratliff's opinion and not to any fundamental deficiency.

6 Finally, Illumina contends that Mr. Ratliff should have considered the price of
7 Illumina stock when Tufts bought the stock (\$5,000) and not the value when Tufts sold
8 the stock (\$7.7 million). Dkt. 168 at 12–13. The inference that Tufts agreed to a lower
9 royalty rate based on a gamble that Illumina would be successful is a reasonable
10 inference as is the fact that Illumina was actually successful. Attacking this inference and
11 fact goes to the weight and not to any fundamental deficiency. Therefore, the Court
12 denies Illumina's motion to exclude Mr. Ratliff's testimony and opinion.

13 III. ORDER

14 Therefore, it is hereby **ORDERED** that Syntrix's motion to strike (Dkt. 145) is
15 **DENIED** and the parties' motions to exclude (Dkts. 150, 168, & 172) are **GRANTED in**
16 **part** and **DENIED in part** as stated herein.

17 Dated this 15th day of February, 2013.

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19 

20 BENJAMIN H. SETTLE
21 United States District Judge
22